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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,598	09/10/2003	Miri Seiberg	JBP-430-CIP1	5368

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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER	
GEMBEH, SHIRLEY V	
ART UNIT	PAPER NUMBER
1618	

NOTIFICATION DATE	DELIVERY MODE
05/14/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jnjuspatent@corus.jnj.com
lhowd@its.jnj.com
gsanche@its.jnj.com

Office Action Summary	Application No.	Applicant(s)	
	10/659,598	SEIBERG ET AL.	
	Examiner	Art Unit	
	SHIRLEY V. GEMBEH	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 February 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *73-86* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *73-86* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. The response filed on **2/24/10** has been entered.

2. Applicant's argument filed on 2/24/10 has been fully considered but they are not deemed to be persuasive.

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 73-86 are pending in this office action. Claim 73 has been amended

Priority

5. Applicant claims that application 09/110,409 contains the subject matter "non-denatured soybean extract". After careful consideration, Applicant's argument is found persuasive. Therefore priority is given to 7/6/1998.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 73-86 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Jin (CN166960A published 12/10/1997) in view of Meybeck et al. (US 5,034,228), for the reasons made of record in Paper No. 20091124 and as follows

Applicant argues that 'First, the compositions set forth in Jin indicate the presence of "soy protein isolate powder" as set forth above. Such powder would constitute only a small proportion of the powder described by Jin: at the most, it would constitute approximately 2 to 5% of the powder composition. Furthermore, while the Office Action is correct in indicating that Jin does not refer to heating steps after addition

of the powder to the composition that would tend to denature the proteins contained therein, nowhere does Jin indicate that the soybean protein isolate powder was not processed prior to addition to the composition. Applicants respectfully conclude that one of ordinary skill in the art would rely upon the ordinary interpretation of the term "soy protein isolate powder" used at the time"

Applicant also argues that "The Meybeck et al. patent relates to "hydrous lipidic lamellar phases or liposomes containing, as an active agent, a retinoid or a structural analogue of retinoid...These compositions are more efficient against acne and less irritant for the skin"

In response Applicant should note that the claims are given its broadest claim interpretation. Jin teaches soy-protein powder in the amount of 2-5% as stated in the remarks, which meets the claim limitation of instant claim 86. The remark above that Jin does not teach the soybean isolate was not processed confirms the Examiner's position. If Jin fails to teach that the soybean extract was processed, one of ordinary skill in the art would reasonably expect that the soy protein isolate was not processed and therefore had not been denatured.

The argument that Jin's soy protein isolate is used for feed for animals is immaterial to the rejection of record what matters is that Jin specifically teach the use of soybean protein powder for treating the face by applying the composition as a mask, wherein after several application of the mask, the acne is obviously decreased.

The declaration is addressed under affidavit below.

The claims are directed to a method of treating acne (Meybeck teaches treating acne) with the same compounds claimed. Therefore it is not clear what is being argued here under Meybeck. As correctly stated in the remarks Meybeck teaches treating acne wherein the composition comprises tretinoin. Also Applicant should note that this is a rejection under 35 USC103, not 35 USC 102.

Applicant's arguments have been fully considered but they are not persuasive.

In summary

Jin teaches using a composition comprising soybean protein powder for treating the face, wherein after several application of the mask, the acne is obviously decreased (see translated abstract, as required by instant claims 73, 75, 77, 78). Because Jin does not heat, etc. his soybean powder, it is therefore considered non-denatured (as required by instant claim 73). Inherently, the soy flour/powder will have trypsin-inhibiting activity because "products of identical chemical composition can not have mutually exclusive properties (see MPEP 2112.01), and because Jin's product was not heated or processed, it is necessarily "not been denatured".

Because Jin teaches that the powders of these natural products are mixed, it is reasonable to conclude that the mixing involves the use of water, and therefore the powder will form a paste when in contact with a liquid or a solvent. Thus it is reasonable to conclude that Jin teaches soybean paste as well (as required by instant claim 74).

However Jin fails to teach the composition for reducing/treating acne further comprises tretinoin.

Meybeck et al. teach treating acne with soya lecithin and tretinoin (as required by instant claims 73-74 and 76-78 are met. See col. 3, lines 36-38 and lines 61-64) wherein the application is topical (as required by instant claim 83, see col. 3, lines 35-37). With regard to claim 75, Meybeck teaches tretinoin as vitamin A, (see col. 2, line 42). Meybeck et al. also teaches the formulation may comprise 2 g of soy lecithin and 0.1 g of tretinoin which is within the recited limitations of 0.01 to about 0.3% tretinoin and 0.01-50% of soybean in claims 79, 81-83 and 85-86 (see col. 3, line 62).

One of ordinary skill in the art would have been motivated to expand use of the treatment composition taught by Jin to incorporate Meybeck's treatment method by substituting the soy lecithin (soybean extract) in Meybeck with the soybean powder/flour of Jin because Jin teaches that when soybean flour is applied to the face, it diminishes acne considerably. One of ordinary skill in the art would routinely add water to the soy flour and form a paste. Therefore the use of soy flour is equivalent to using soy paste as required by instant claim 74. Since tretinoin is known in the art to be interchangeable with retinoid or vitamin A, one of ordinary skill in the art would have employed either tretinoin or vitamin A in a composition for treating acne since vitamin A is well known in the art for treating acne.

Affidavit

7. The declaration submitted by Miri Seiberg under 37 CFR 1.132 filed 2/24/10 is insufficient to overcome the rejection of claims 73-86 based upon the combination of prior art Jin (CN166960A published 12/10/1997) in view of Meybeck et al. (US 5,034,228) as set forth in the last Office action because:

The exhibits submitted are immaterial to the rejection at hand. For example Williams et al. (Br. J. Nut. Exhibit A) teaches about diets. The claims are directed topically administering soybean extract that has not been denatured.

Bedo et al (Arch Tierernahr) teaches digestibility in calves.

Timmons et al. teaches about biologic value.

Sarwar et al. teaches amino acid profiles and protein digestibility.

Khorasani et al. teach replacement of milk protein by soy protein etc.

In other words, none of the articles submitted teach what is being claimed.

Also in other to show that Jin's product was denatured and therefore not having "trypsin-inhibiting activity", there should be a side by side comparison of Applicant's invention and Jin's invention showing that Jin's isolate truly is denatured. Accordingly, the courts have held that if the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *In re Thorpe,* 227 USPQ 964, 966 (Fed. Cir. 1985): *In re Marosi*, 218 USPQ 289, 292-293 (Fed. Cir. 1983).

Likewise, the courts have held that when the prior art product reasonably appears to be the same as that claimed, but differs by process in which it is produced, a rejection of this nature is eminently fair and the burden is upon the appellants to prove, by comparative evidence, a patentable difference (*In re Brown*, 173 USPQ 685 (1972)).

8. No claim is allowed.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHIRLEY V. GEMBEH whose telephone number is (571)272-8504. The examiner can normally be reached on 8:30 -5:00, Monday- Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL HARTLEY can be reached on 571-272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S.V.G./
Examiner, Art Unit 1618
5/3/10

/Robert C. Hayes/
Primary Examiner, Art Unit 1649